

REMARKS

Claims 1-40 are pending. In view of the following remarks, Applicant respectfully requests withdrawal of the rejections and forwarding of the application on to issuance.

Claim Rejections

Claims 1, 3-4, 16 and 28-30 stand rejected under 35 U.S.C. § 103(a) over a publication to Shannon entitled "Java 2 Platform Enterprise Edition Specification, v1.2" (hereinafter "Shannon") in view of a publication to Sun entitled "Java 2 platform, Standard Edition, v 1.2.2 API Specification" (hereinafter "Sun").

Claims 5-15 and 31-40 stand rejected under 35 U.S.C. § 103(a) over Sun in view of a publication to Flanagan entitled "Java in a NutShell", (hereinafter "Flanagan").

Claims 2 and 17-27 stand rejected under 35 U.S.C. § 103(a) over Shannon and Sun, in view of Flanagan.

The § 103 Standard

To establish a prima facie case of obviousness, three basic criteria *must* be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992); *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988). Second, there must be a reasonable expectation of success. *In re Merck & Co., Inc.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986). Finally, the prior art reference (or references when combined) must teach

1 or suggest all the claim limitations. *In re Royka*, 490 F.2d 981, 180 USPQ 580
2 (CCPA 1974).

3 Hence, when patentability turns on the question of obviousness, the search
4 for and analysis of the prior art includes evidence relevant to the finding of
5 whether there is a teaching, motivation, or suggestion to select and combine the
6 references relied on as evidence of obviousness. See, e.g., *McGinley v. Franklin*
7 *Sports, Inc.*, 262 F.3d 1339, 1351-52, 60 USPQ2d 1001, 1008 (Fed. Cir. 2001)
8 ("the central question is whether there is reason to combine [the] references," a
9 question of fact drawing on the Graham factors).

10 "The factual inquiry whether to combine references must be thorough and
11 searching." *Id.* It must be based on objective evidence of record. This precedent
12 has been reinforced in myriad decisions, and cannot be dispensed with. See, e.g.,
13 *Brown & Williamson Tobacco Corp. v. Philip Morris Inc.*, 229 F.3d 1120, 1124-
14 25, 56 USPQ2d 1456, 1459 (Fed. Cir. 2000) ("a showing of a suggestion,
15 teaching, or motivation to combine the prior art references is an 'essential
16 component of an obviousness holding'" (quoting *C.R. Bard, Inc., v. M3 Systems,*
17 *Inc.*, 157 F.3d 1340, 1352, 48 USPQ2d 1225, 1232 (Fed. Cir. 1998)); *In re*
18 *Dembiczak*, 175 F.3d 994, 999, 50 USPQ2d 1614, 1617 (Fed. Cir. 1999) ("Our
19 case law makes clear that the best defense against the subtle but powerful
20 attraction of a hindsight-based obviousness analysis is rigorous application of the
21 requirement for a showing of the teaching or motivation to combine prior art
22 references."); *In re Dance*, 160 F.3d 1339, 1343, 48 USPQ2d 1635, 1637 (Fed.
23 Cir. 1998) (there must be some motivation, suggestion, or teaching of the
24 desirability of making the specific combination that was made by the applicant);
25 *In re Fine*, 837 F.2d 1071, 1075, 5 USPQ2d 1596, 1600 (Fed. Cir. 1988)

1 ("teachings of references can be combined only if there is some suggestion or
2 incentive to do so.") (emphasis in original) (quoting *ACS Hosp. Sys., Inc. v.*
3 *Montefiore Hosp.*, 732 F.2d 1572, 1577, 221 USPQ 929, 933 (Fed. Cir. 1984)).

4 The need for specificity pervades this authority. See, e.g., *In re Kotzab*,
5 217 F.3d 1365, 1371, 55 USPQ2d 1313, 1317 (Fed. Cir. 2000) ("particular
6 findings must be made as to the reason the skilled artisan, with no knowledge of
7 the claimed invention, would have selected these components for combination in
8 the manner claimed").

9 In view of the § 103 Standard set forth above, Applicant respectfully
10 submits that the Office has not established a *prima facie* case of obviousness.

11 12 The Claims

13 **Claim 1** recites a software architecture for a distributed computing system
14 comprising:

- 15 • an application configured to handle requests submitted by remote
- 16 devices over a network; and
- 17 • an application program interface to present functions used by the
- 18 application to access network and computing resources of the
- 19 distributed computing system, the application program interface
- 20 comprising various types related to constructing user interfaces.

21 In making out the rejection of this claim, the Office argues that Shannon
22 discloses all of the subject matter of this claim except for an application program
23 interface comprising various types related to constructing user interfaces. The
24 Office then relies on Sun and argues that it teaches an API comprising various
25 types related to constructing user interfaces. The Office then reasons that it

1 would have been obvious to combine the teachings of Shannon and Sun "because
2 Shannon' system is based on J2SE (page 6.1, i.e. J2SE is part of J2EE) and sun
3 teaches J2SE is used to construct the client side which includes user interface, to
4 provide complete teaching of J2EE". Applicant respectfully disagrees and
5 submits that the Office has not established a *prima facie* case of obviousness.

6 In Applicant's previous response filed November 1, 2004, Applicant
7 submitted that the Office's stated motivation to combine these references is
8 misplaced and does not rise to the level of supporting a *prima facie* case of
9 obviousness. Applicant reminded the Office that to support the conclusion that
10 the claimed invention is directed to obvious subject matter, either the references
11 must expressly or impliedly suggest the claimed invention or the examiner must
12 present a convincing line of reasoning as to *why* the artisan would have found the
13 claimed invention to have been obvious in light of the teachings of the references.
14 See, e.g. *Ex parte Clapp*, 227 USPQ 972, 973 (Bd. Pat. App. & Inter. 1985).
15 Here, the Office's attempt at a "convincing line of reasoning" is to state simply
16 that "Shannon' system is based on J2SE and Sun teaches J2SE is used to
17 construct the client side which includes user interface, to provide complete
18 teaching of J2EE". Applicant explained that this statement fails to give a specific
19 reason *why* the claimed subject matter would be obvious in view of the cited
20 references.

21 In response to Applicant's arguments, the Office refers to page 6-1 of
22 Shannon in reasoning that "J2SE APIs is part of the J2EE APIs." The Office then
23 argues that one would have been motivated to combine the teachings of Shannon
24 and Sun "for complete teaching of all the APIs that are supported by the J2EE."
25

1 Without addressing the substantive features of the cited references (which
2 Applicant submits do not teach all features of the claimed subject matter),
3 Applicant respectfully disagrees and submits that the Office's stated motivation to
4 combine these references is misplaced and still fails to give a specific reason *why*
5 the claimed subject matter would be obvious in view of the cited references. In
6 this regard, despite the fact that Shannon and Sun appear to involve distinct
7 products, the Office appears to argue that an artisan would have inexplicably been
8 motivated to combine their teachings. The existence of any such motivation
9 seems unlikely, especially when considering that Shannon appears to teach away
10 from disregarding this distinction in so far as it states that in regards to J2EE
11 application components: "...we do not want to subset the J2SE platform, and we
12 want a J2SE product to be usable without modification by the J2EE Product
13 Providers in the J2EE platform ..." (Shannon, page 6-3). Accordingly, despite
14 the Office's stated motivation, it remains unclear why an artisan would be
15 motivated to make such a combination.

16 Perhaps more importantly, Applicant submits that upon close inspection,
17 the Office's stated motivation "for complete teaching of all the APIs that are
18 supported by the J2EE" merely recites the prior art by referring to the disclosure
19 of Shannon (J2EE) - which is unacceptable. In this regard, the Office has
20 provided a paper, available at the following link:

21
22 <http://www.uspto.gov/web/menu/busmethp/busmeth103rej.htm>
23

24 that describes proper and improper rejections made under §103(a).
25 Particularly instructive is a portion that appears in Section IV of the paper which

provides guidance in regards to communicating a proper §103(a) rejection. The pertinent part of this paper is reproduced below for the Office's convenience:

IV. Communicating the Rationale for a Proper Rejection under 35 U.S.C. 103

When an examiner rejects a claim as failing to meet one or more of the statutory requirements for patentability, administrative due process and 35 U. S.C. 132 require that applicant be adequately notified of the reasons for the rejection of the claim so that applicant can decide how to proceed. The statutory requirement that an Office action state the reasons for any rejection is critical to proper action taking.

In writing a rejection under 35 U.S.C. 103, the examiner should appropriately communicate:

- (1) the particular part of a reference being relied upon should be designated as nearly as practicable; 37 CFR § 1.104(c)(2);
- (2) the differences between the claimed invention and the closest prior art;
- (3) where the differences are found or suggested in the prior art;
- (4) how the teachings of the prior art are combined; and
- (5) *why the combination of those teachings would have been obvious to one of ordinary skill in the art at the time the invention was made. Do not recite the disclosure of the prior art which reads on the claimed invention as the motivation. Communicate why the references themselves, the knowledge of one of ordinary skill in the art, or the nature of the problem to be solved establishes a motivation to combine the prior art references.*

Once applicant has presented rebuttal evidence, examiners should reconsider any initial obviousness determination in view of the entire record. All the proposed rejections and their bases should be reviewed to confirm their correctness. Only then should any rejection be imposed in an Office action. The Office action should clearly communicate the Office's findings and conclusions, *articulating how the conclusions are supported by the findings.*

Here, as discussed above, the Office's stated motivation merely recites the disclosure of the prior art and is unacceptable, as demonstrated by the Office's own guidance given above.

1 Applicant submits that the Office has failed to establish a *prima facie* case
2 of obviousness for at least the reason that the Office has failed to provide a
3 specific reason why the claimed subject matter would be obvious in view of the
4 cited references. Accordingly, Applicant traverses the Office's rejection.

5 Claims 2-4 depend from claim 1 and are allowable as depending from an
6 allowable base claim. In addition, given the Office's failure to establish a *prima*
7 *facie* case of obviousness, the Office's reliance on Flanagan in making out the
8 rejection of claim 2 is not seen to add anything of significance.

9 Claim 5 recites an application program interface embodied on one or more
10 computer readable media, comprising: multiple types related to constructing user
11 interfaces, the types comprising classes, interfaces, delegates, structures and
12 enumerations.

13 In making out the rejection of this claim, the Office argues that Sun
14 discloses all of the subject matter of this claim except for types comprising
15 delegates, structures and enumerations. The Office then relies on Flanagan and
16 argues that it teaches delegates and enumerations and argues that it would be
17 obvious to combine Sun and Flanagan to render the claimed subject matter
18 obvious "because Flanagan clearly show[s] the description of the API supported
19 by Sun." In addition, the Office argues that "although Sun does not teach
20 structures, it would have been obvious the structures are supported because Sun
21 supports abstract class which function as structure." Applicant does not
22 understand the Office's line of reasoning and submits that the Office has failed to
23 establish a *prima facie* case of obviousness.

24 In Applicant's previous response filed November 1, 2004, Applicant
25 submitted that the Office's stated motivation to combine these references is

1 misplaced and does not rise to the level of supporting a *prima facie* case of
2 obviousness. Applicant argued that the Office's stated motivation: "because
3 Flanagan clearly show the description of the API supported by Sun fails to make
4 particular findings as to the reason why the claimed subject matter would be
5 obvious in view of the cited references.

6 In response to Applicant's arguments, the Office states: "Sun teaches the
7 Java 2 Platform, Standard Edition which provides the list of packages that are
8 supported, and Flanagan teaches the details of those packages. Therefore,
9 combination of Sun and Flanagan is to provide a complete teaching of Java 2
10 Platform Standard Edition APIs."

11 Without addressing the substantive features of the cited references (which
12 Applicant submits do not teach all features of the claimed subject matter),
13 Applicant respectfully disagrees and submits that the Office's stated motivation to
14 combine these references is misplaced and still fails to give a specific reason *why*
15 the claimed subject matter would be obvious in view of the cited references. In
16 this regard, Applicant submits that upon close inspection, the Office's stated
17 motivation "provide a complete teaching of Java 2 Platform Standard Edition
18 APIs" merely recites the Sun reference (Sun is titled "Java™ 2 Platform,
19 Standard Edition, v1.2.2 API Specification"). As discussed above, a stated
20 motivation that merely recites the disclosure of the prior art is unacceptable, as
21 demonstrated by the Office's own guidance given above.

22 Applicant respectfully submits that the Office has not made particular
23 findings as to the reason the claimed subject matter would be obvious in view of
24 the cited references. Accordingly, Applicant traverses the Office's rejection.
25

1 **Claims 6-15** depend from claim 5 and are allowable as depending from an
2 allowable base claim.

3 **Claim 16** recites a distributed computer software architecture, comprising:

- 4
- 5 • one or more applications configured to be executed on one or more
6 computing devices, the applications handling requests submitted
7 from remote computing devices;
 - 8 • a networking platform to support the one or more applications; and
 - 9 • an application programming interface to interface the one or more
10 applications with the networking platform, the application
11 programming interface comprising various types related to
12 constructing user interfaces.

13 In making out the rejection of this claim, the Office argues that Shannon
14 discloses all of the subject matter of this claim except for an application program
15 interface comprising various types related to constructing user interfaces. The
16 Office then relies on Sun and argues that it teaches an API comprising various
17 types related to constructing user interfaces. The Office then reasons that the
18 combination of Shannon and Sun would render the subject matter of this claim
19 obvious, and states the following as a motivation to combine the references:
20 “because Shannon’s system is based on J2SE and Sun teaches J2SE is used to
21 construct the client side which includes the user interface, to provide complete
22 teaching of J2EE.” Applicant respectfully disagrees and submits that the Office
23 has not established a *prima facie* case of obviousness.

24 In Applicant’s previous response filed November 1, 2004, Applicant
25 submitted that the Office’s stated motivation to combine these references is
misplaced and does not rise to the level of supporting a *prima facie* case of
obviousness. Here, the Office’s attempt at a “convincing line of reasoning” is to

1 state simply that "Shannon's system is based on J2SE and Sun teaches J2SE
2 issued to construct the client side which includes user interface, to provide
3 complete teaching of J2EE". Applicant explained that this statement fails to give
4 a specific reason *why* the claimed subject matter would be obvious in view of the
5 cited references.

6 In response to Applicant's arguments, the Office refers to page 6-1 of
7 Shannon in reasoning that "J2SE APIs is part of the J2EE APIs." The Office then
8 argues that one would have been motivated to combine the teachings of Shannon
9 and Sun "for complete teaching of all the APIs that are supported by the J2EE."

10 Without addressing the substantive features of the cited references (which
11 Applicant submits do not teach all features of the claimed subject matter),
12 Applicant respectfully disagrees and submits that the Office's stated motivation to
13 combine these references is misplaced and still fails to give a specific reason *why*
14 the claimed subject matter would be obvious in view of the cited references. As
15 discussed above, any motivation to combine Shannon and Sun seems unlikely,
16 especially when considering that they appear to involve distinct products and that
17 Shannon appears to teach away from disregarding this distinction. Furthermore,
18 as discussed above, the Office's stated motivation "for complete teaching of all
19 the APIs that are supported by the J2EE" merely recites the prior art by referring
20 to the disclosure of Shannon (J2EE) - which is unacceptable.

21 Applicant submits that the Office has failed to establish a *prima facie* case
22 of obviousness for at least the reason that the Office has failed to provide a
23 specific reason why the claimed subject matter would be obvious in view of the
24 cited references. Accordingly, Applicant traverses the Office's rejection.
25

1 **Claims 17-27** depend from claim 16 and are allowable as depending from
2 an allowable base claim.

3 **Claim 28** recites a computer system including one or more
4 microprocessors and one or more software programs, the one or more software
5 programs utilizing an application program interface to request services from an
6 operating system, the application program interface including separate commands
7 to request services comprising services related to constructing user interfaces.

8 In making out the rejection of this claim, the Office argues that Shannon
9 discloses all of the subject matter of this claim except for an application program
10 interface including separate commands to request services comprising services
11 related to constructing user interfaces. The Office then relies on Sun and argues
12 that it teaches an API comprising various types related to constructing user
13 interfaces. The Office then reasons that the combination of Shannon and Sun
14 would render the subject matter of this claim obvious, and states the following as
15 a motivation to combine the references: "because Shannon's system is based on
16 J2SE and Sun teaches J2SE is used to construct the client side which includes the
17 user interface, to provide complete teaching of J2EE." Applicant respectfully
18 disagrees and submits that the Office has not established a *prima facie* case of
19 obviousness.

20 In Applicant's previous response filed November 1, 2004, Applicant
21 submitted that the Office's stated motivation to combine these references is
22 misplaced and does not rise to the level of supporting a *prima facie* case of
23 obviousness. Here, the Office's attempt at a "convincing line of reasoning" is to
24 state simply that "Shannon's system is based on J2SE and Sun teaches J2SE
25 issued to construct the client side which includes user interface, to provide

1 complete teaching of J2EE". Applicant explained that this statement fails to give
2 a specific reason *why* the claimed subject matter would be obvious in view of the
3 cited references.

4 In response to Applicant's arguments, the Office refers to page 6-1 of
5 Shannon in reasoning that "J2SE APIs is part of the J2EE APIs." The Office then
6 argues that one would have been motivated to combine the teachings of Shannon
7 and Sun "for complete teaching of all the APIs that are supported by the J2EE."

8 Without addressing the substantive features of the cited references (which
9 Applicant submits do not teach all features of the claimed subject matter),
10 Applicant respectfully disagrees and submits that the Office's stated motivation to
11 combine these references is misplaced and still fails to give a specific reason *why*
12 the claimed subject matter would be obvious in view of the cited references. As
13 discussed above, any motivation to combine Shannon and Sun seems unlikely,
14 especially when considering that they appear to involve distinct products and that
15 Shannon appears to teach away from disregarding this distinction. Furthermore,
16 as discussed above, the Office's stated motivation "for complete teaching of all
17 the APIs that are supported by the J2EE" merely recites the prior art by referring
18 to the disclosure of Shannon (J2EE) - which is unacceptable.

19 Applicant submits that the Office has failed to establish a *prima facie* case
20 of obviousness for at least the reason that the Office has failed to provide a
21 specific reason why the claimed subject matter would be obvious in view of the
22 cited references. Accordingly, Applicant traverses the Office's rejection.

23 **Claim 29** recites a method, comprising:

- 24
- 25 • managing network and computing resources for a distributed computing system; and

- exposing a set of functions that enable developers to access the network and computing resources of the distributed computing system, the set of functions comprising functions to facilitate construction of user interfaces.

In making out the rejection of this claim, the Office simply indicates "see rejection of claim 1 above." For the reasons stated above with respect to claim 1 and the Office's failure to articulate an appropriate motivation to combine the cited references, the Office has failed to establish a *prima facie* case of obviousness and this claim is allowable.

Claim 30 depends from claim 29 and is allowable as depending from an allowable base claim.

Claim 31 recites a method, comprising creating a namespace with functions that enable drawing and construction of user interfaces, the name space defining classes, interfaces, delegates, structures and enumerations.

In making out the rejection of this claim, the Office does not appear to take a position with respect to its patentability in view of the cited references (See, Office Action, Page 9, ¶ 32). It appears that the Office may have intended to reject this claim in a similar manner as was used to reject claim 5 above. If this is the case, then for the reasons set forth above with respect to the Office's failure to articulate a proper motivation to combine the cited references, this claim is allowable.

Claims 32-40 depend from claim 31 and are allowable as depending from an allowable base claim.

Conclusion

Applicant respectfully submits that the Office has failed to establish a *prima facie* case of obviousness for the reasons set forth above. Applicant respectfully requests a Notice of Allowability be issued forthwith. If the next anticipated action is to be anything other than issuance of a Notice of Allowability, Applicant respectfully requests a telephone call for the purpose of scheduling an interview.

Respectfully submitted,

Dated: 7/12/05By: 

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